Appl. No. 10/597,277
Response to Office Action of October 6, 2009

PATENT
Docket No.: US040043US2
Customer No. 24737

REMARKS

By this amendment, claims 1, 6, 10, 11 and 17 have been amended. Claims 1-21 remain in the application. Support for the amendments can be found the specification and drawings as originally filed. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, is respectfully requested.

Objection to the Claims

Claims 1, 6, 10 and 17 stand objected to because of informalities. The objection is traversed for at least the following reasons. By this amendment, claims 1, 6, 10 and 17 have been amended to remove the words "adapted to be" from the respective claims. The objection to the claims is now believed overcome. Withdrawal of the objection is requested.

Rejection under 35 U.S.C. §103

Claim 1 recites a playlist generator apparatus comprising:

a first selector device that accesses and searches at least one database source of material and provides therefrom a first subset of identifications of items within the at least one database source of material at a highest hierarchical level, based on a first set of parameters corresponding to a first set of user preferences, further wherein the first selector device accesses and searches available database sources of material on a weekly basis to maintain the first subset of identifications of items up to date, and

a second selector device operatively coupled to the first selector device, wherein the second selector device searches the first subset of identifications at a lower hierarchical level based on a second set of parameters corresponding to a second set of user preferences, and provides therefrom a second subset of identifications of items within the database source of material, wherein the second subset corresponds to a playlist that is used by a rendering device for a subsequent rendering of the items identified in the second subset.

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Support for the amendments to claim 1 (as well as for claims 11 and 17) can be found in the specification at least on page 3, lines 7-13; page 7, lines 22-31; and FIGs. 1 and 2.

Claims 1-5, 11-13, 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hoch (U.S. Pub. No. US 2003/0191753 AI), hereinafter **Hoch**, in view of Barton et al. (U.S. Pub. No. US 2002/0072982 AI), hereinafter **Barton**. With respect to claim 1, as presented herein, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:
> ... *The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

1.   Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Hoch** and **Barton** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:
> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the <u>subject matter as a whole</u> would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...* (Emphasis added)

Thus, when evaluating a claim for determining obviousness, <u>all limitations of the claim must be evaluated</u>. However, since neither **Hoch** nor **Barton** teaches a playlist generator apparatus comprising:

> *(i)* a **first selector device** that ...

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> *(i)(a) accesses* and *searches* at least one database source of material and
> provides therefrom… a *first subset* of identifications of items within the …
> *database source of material* at a <u>*highest*</u> hierarchical level, *based on a first set of
> parameters* corresponding to a first set of user preferences, *further …*
>
> > *(i)(b) … accesses* and *searches available database sources* of material on a
> > *weekly basis* to <u>*maintain*</u> the *first subset* of identifications of items up to date,
> > <u>and</u>
>
> *(ii)* a ***second selector device*** operatively *coupled* to the ***first selector device***
> [that] …
>
> > *(ii)(a) …* searches the *first subset* of identifications at a <u>*lower*</u> hierarchical
> > level based on a *second set of parameters* corresponding to a second set of user
> > preferences, *and …*
>
> > *(ii)(b)* provides … *a second subset* of identifications of items within the
> > *database source of material*, wherein the second subset … *[is]* a *playlist* … *used*
> > by a rendering device for a subsequent rendering of the items identified in the
> > second subset [emphasis added]

as now claimed in claim 1, it is impossible to render the subject matter of claim 1 as a
whole obvious, and the explicit terms of the statute cannot be met.

In addition, claim 1 now more clearly discloses "a first selector device that
accesses and searches at least one database source of material". Accordingly, the
claim language now more clearly discloses (and as can reasonably be interpreted from
the same) that the at least one database is connected <u>*all*</u> the time, i.e., with the first
selector device.

In contrast, **Hoch** teaches filtering content with a multilevel hierarchical searching
method based on a user's persona information using a learning mechanism. In
particular, as illustrated in FIG. 6 thereof, the method of **Hoch** performs a search for
content at one or more nodes of the community (step 602), filters the information
received from the one or more notes in response to the search (step 603), generates a

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search result (step 604), presents the search result (step 605), queries whether the user is satisfied (step 607), and if not satisfied, then receives a [user's] selection of at least a portion of the search result (step 606) and returns to step 602 wherein the method again searches the content at one or more nodes of the community (step 602) and thereafter repeats [emphasis added] (See Hoch at paragraph [0071] and [0074]-[0076]). Accordingly, while **Hoch** discloses filtering using multiple levels of details and a learning algorithm based on a user's persona information, the method of **Hoch** teaches repeated searching the *nodes* of the *community* at the successive levels of the multilevel hierarchical searching. Accordingly, **Hoch** does not teach or suggest the limitations as specifically recited in claim 1 of the present application.

In further contrast, **Barton** does not supply that which is missing from **Hoch**. **Barton** teaches a method for interacting with a user that employs a *captured sample* of an *experimental environment* in which the *user* exists as a *command* to *trigger* subsequent events (see Barton at paragraph [0006]). In paragraph [0013], **Barton** discloses that "a personal digital assistant or computer could be specially enabled to act as the *interactive service itself* by *storing the database* in its memory and *performing* the *database query* and *processing* without *externally accessing* the *service*." **Barton** further discloses in paragraph [0013] that "transmission to the service provider would *only be needed* for additional interaction and *potentially* for *updates* of the *music database*, such as periodically (e.g., *weekly*)." In other words, the database (corresponding to the *service*) that would be stored on the personal digital assistant or computer is configured to operate without externally accessing the service (i.e., accessing the external database), *except for* additional interaction or updates to the database *stored on* the *PDA* or *computer*. Accordingly, **Barton** does not teach or suggest the limitations as specifically recited in claim 1 of the present application.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

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2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Hoch** and **Barton** references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> ...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Hoch** nor **Barton** teaches, or even suggests, the desirability of the combination since neither teaches the specific playlist generator apparatus that includes *(i)* a *first selector device* that … *(i)(a)* *accesses* and *searches* at least one database source of material and provides therefrom … a *first subset* of identifications of items within the … *database source of material* at a <u>*highest*</u> hierarchical level, *based on* a *first set of parameters* corresponding to a first set of user preferences, *further* … *(i)(b)* … *accesses* and *searches available database sources* of material on a *weekly basis* to <u>*maintain*</u> the *first subset* of identifications of items up to date, <u>and</u> *(ii)* a *second selector device* operatively *coupled* to the *first selector device* [that] … *(ii)(a) searches* the *first subset* of identifications at a <u>*lower*</u> hierarchical level based on a *second set of parameters* corresponding to a second set of user preferences, *and* … *(ii)(b)* provides … a *second subset* of identifications of items within the *database source of material*, wherein the second subset … *[is]* a *playlist* … *used* by a rendering device for a subsequent rendering of the items identified in the second subset [emphasis added]" as specified above and as claimed in claim 1.

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Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination as suggested by the office action arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claims 2-5 depend from and further limit independent claim 1 and therefore are allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Independent claim 11 has been amended herein to include limitations similar to those of claim 1. Accordingly, claim 11 is believed allowable for at least the same reasons as presented herein above with respect to overcoming the rejection of claim 1, and an early formal notice thereof is requested. Claims 12 and 13 depend from and further limit independent claim 11 and therefore are allowable as well. Accordingly, the

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35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Independent claim 17 has been amended herein and includes limitations similar to those of claim 1. Accordingly, claim 17 is believed allowable for at least the same reasons as presented herein above with respect to overcoming the rejection of claim 1, and an early formal notice thereof is requested. Claim 18 depends from and further limits independent claim 17 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claims 6, 14 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Hoch**, in view of **Barton** as applied to claims 1, 11 and 17 above, in view of Salam et al. (U.S. Patent No. U.S. 6,594,654, hereinafter **Salam**). Applicant respectfully traverses this rejection for at least the following reason. Claim 6 depends from and further limits allowable independent claim 1 and therefore is allowable as well. Claim 14 depends from and further limits allowable independent claim 11 and therefore is allowable as well. Claim 21 depends from and further limits allowable independent claim 17 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claims 7-9, 15, 16, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Hoch**, in view of **Barton** as applied to claims 1, 11 and 17 above, in view of Breese et al. (U.S. Patent No. U.S. 6,006, 218, hereinafter **Breese**). Applicant respectfully traverses this rejection for at least the following reason. Claims 7-9 depend from and further limit allowable independent claim 1 and therefore are allowable as well. Claims 15 and 16 depend from and further limit allowable independent claim 11 and therefore are allowable as well. Claims 19 and 20 depend from and further limit

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allowable independent claim 17 and therefore are allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Hoch**, in view of **Barton**, and further in view of **Breese**, as applied to claim 7 above, and further in view of **Salam**. Applicant respectfully traverses this rejection for at least the following reason. Claim 10 depends from and further limits allowable independent claim 1 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 11 and 17 are in condition for allowance. Dependent claims 2-10 depend from and further limit independent claim 1 and therefore are allowable as well. Dependent claims 12-16 depend from and further limit independent claim 11 and therefore are allowable as well. Dependent claims 18-21 depend from and further limit independent claim 17 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-21 is requested.

Respectfully submitted,

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